

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86660632
LAW OFFICE ASSIGNED	LAW OFFICE 112
MARK SECTION	
MARK	http://tmng-al.uspto.gov/resting2/api/img/86660632/large
LITERAL ELEMENT	EPIX
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_631381729-20161014105350253177 . ponse to Final Office Action EPIX Word Mark_F2071228x96B9E .pdf
CONVERTED PDF FILE(S) (3 pages)	\\TICRS\EXPORT17\IMAGEOUT17\866\606\86660632\xml1\RFR0002.JPG
	\\TICRS\EXPORT17\IMAGEOUT17\866\606\86660632\xml1\RFR0003.JPG
	\\TICRS\EXPORT17\IMAGEOUT17\866\606\86660632\xml1\RFR0004.JPG
DESCRIPTION OF EVIDENCE FILE	Response to refusal to register the mark based on Section 2(d).
GOODS AND/OR SERVICES SECTION (009)(no change)	
GOODS AND/OR SERVICES SECTION (016)(no change)	
GOODS AND/OR SERVICES SECTION (041)(no change)	
GOODS AND/OR SERVICES SECTION (042)(current)	
INTERNATIONAL CLASS	042
DESCRIPTION	
Providing a website featuring technology enabling users to view, share and download digital photographs; computer services, namely, electronic imaging of photographs	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (042)(proposed)	
INTERNATIONAL	042

CLASS	
TRACKED TEXT DESCRIPTION	
Providing a website featuring technology enabling users to view, share and download digital photographs; <u>Providing a website featuring technology enabling users to view, share and download digital photographs featuring vacations, engagements and weddings, for personal use;</u> computer services, namely, electronic imaging of photographs; <u>computer services, namely, electronic imaging of photographs featuring vacations, engagements and weddings, for personal use</u>	
FINAL DESCRIPTION	
Providing a website featuring technology enabling users to view, share and download digital photographs featuring vacations, engagements and weddings, for personal use; computer services, namely, electronic imaging of photographs featuring vacations, engagements and weddings, for personal use	
FILING BASIS	Section 1(b)
SIGNATURE SECTION	
RESPONSE SIGNATURE	/tnb/
SIGNATORY'S NAME	Tamar Niv Bessinger
SIGNATORY'S POSITION	Attorney of Record, New York State Bar Member
DATE SIGNED	10/14/2016
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Fri Oct 14 11:05:41 EDT 2016
TEAS STAMP	USPTO/RFR-XX.XXX.XXX.X-20 161014110541184936-866606 32-5706ef3943c413b0a5f723 bb3edb52a7f6648464d1aa26f 4aff945553ac99e2fe-N/A-N/ A-20161014105350253177

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 PTO Form 1960 (Rev 10/2011)
 OMB No. 0651-0050 (Exp 07/31/2017)

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To the Commissioner for Trademarks:

Application serial no. **86660632** EPIX(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/86660632/large>) has been amended as follows:

EVIDENCE

Evidence in the nature of Response to refusal to register the mark based on Section 2(d). has been attached.

Original PDF file:

[evi_631381729-20161014105350253177_-_ponse to Final Office Action EPIX Word Mark_F2071228x96B9E_.pdf](#)

Converted PDF file(s) (3 pages)

[Evidence-1](#)

[Evidence-2](#)

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 042 for Providing a website featuring technology enabling users to view, share and download digital photographs; computer services, namely, electronic imaging of photographs

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application: As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

Proposed:

Tracked Text Description: ~~Providing a website featuring technology enabling users to view, share and download digital photographs;~~
[Providing a website featuring technology enabling users to view, share and download digital photographs featuring vacations, engagements and weddings, for personal use;](#) ~~computer services, namely, electronic imaging of photographs;~~ [computer services, namely, electronic imaging of photographs featuring vacations, engagements and weddings, for personal use](#)

Class 042 for Providing a website featuring technology enabling users to view, share and download digital photographs featuring vacations, engagements and weddings, for personal use; computer services, namely, electronic imaging of photographs featuring vacations, engagements and weddings, for personal use

Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application: As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /tnb/ Date: 10/14/2016

Signatory's Name: Tamar Niv Bessinger

Signatory's Position: Attorney of Record, New York State Bar Member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86660632

Internet Transmission Date: Fri Oct 14 11:05:41 EDT 2016

TEAS Stamp: USPTO/RFR-XX.XXX.XXX.X-20161014110541184

936-86660632-5706ef3943c413b0a5f723bb3ed

b52a7f6648464d1aa26f4aff945553ac99e2fe-N

/A-N/A-20161014105350253177

Argument for Response to Office Action, EPIX, SN 86/660,632

Registration in Class 42 only has been refused based on U.S. Reg. No 4,210,817 for EPIX (the “Cited Mark”) by Fidelity National Card Services, on the grounds of likelihood of confusion. Due to the differences in the target consumers—commercial customers versus individual end consumers—confusion is not likely. Applicant thus respectfully requests that the citation be withdrawn.

The Cited Mark is registered for:

Computer services, namely, custom electronic imaging of photographs, artwork, images, or other visual media onto customized credit, debit, incentive, loyalty, gift, and greeting cards, and electronic imaging of photographs, artwork, images, or other visual media onto carriers for all of the foregoing; photographic computer imaging services for commercial use

Applicant has now amended its Class 42 services to:

“Providing a website featuring technology enabling users to view, share and download digital photographs *featuring vacations, engagements and weddings, for personal use*; computer services, namely, electronic imaging of photographs *featuring vacations, engagements and weddings, for personal use*.”

It is apparent from the ID of the Cited Mark that the mark is used for services for commercial customers and not for individual end consumers. Based on the first clause of the ID, “custom electronic imaging of photographs, artwork, images, or other visual media onto customized credit, debit, incentive, loyalty, gift, and greeting cards,” it is clear that the customers for such services are businesses such as banks that would have their own marks or logos printed onto credit cards, loyalty and gift cards and the like. These are not services that a non-commercial customer would ever receive. Moreover, the last clause of the ID, “photographic computer imaging services *for commercial use*” explicitly states that the services are for commercial use. Indeed, registrant’s website <http://www.fisglobal.com/empoweredclients> shows

that many of its clients—indeed all client profiled under the “Client Stories” page of its website, are banks and financial institutions (See screenshot at Exhibit A).

In sharp contrast, the updated ID for Applicant’s mark explicitly provides that its services are for *personal use* only, and specifically feature photos of vacations, engagements, and weddings, which are clearly *personal* experiences.

Because the target consumers for services under the Cited Mark and Applicant’s mark, are mutually exclusive, consumers will never encounter both marks for the respective services, and therefore there is no potential for confusion. Moreover, based on the vast differences in target markets, it logically follows that such services will be advertised and delivered through mutually exclusive channels of trade.

Based on the foregoing, Applicant respectfully requests that the blocking citation be withdrawn, and the application forwarded for publication.

Exhibit A

<http://www.fisglobal.com/empoweredclients>

OUR CLIENT STORIES



Atom, the designed-for-digital challenger to the U.K. banking market, partnered with FIS to serve banking customers on the go. Launched in April 2016 – with no branches and no call centers – the digital-only bank is delivering directly to smart devices of U.K. millennials. FIS is empowering Atom with a cost-effective outsourced infrastructure and expertise that enables the bank to launch new services quickly and confidently.

[Read more](#)



Before FIS partnered with Bharatiya Mahila Bank (BMB), only 25% of Indian women had the most basic financial building block – a savings account. FIS and BMB set out to change that, powering the country's first bank for women. Together we are helping all of India's 505,303,000 women to experience economic growth and enjoy personal financial freedom.

[Read more](#)



As Centennial Bank began to experience big growth, it had to replace its manual GS&A/AML compliance processes. FIS provided automated compliance solutions helped Centennial cut the chains of manual processes, save time and resources, and better detect and report suspicious activity.

[Read more](#)



eftpos, Australia's largest and most used payments network, needed to implement new payment innovation but was constrained by decade-old infrastructure. FIS and eftpos together replaced the old network of 27 independent subnetworks with a single high-volume payments hub that powers over 8,000,000 transactions daily.

[Read more](#)



Kitsap Bank wanted to leverage online customer data to forge deeper, more profitable and lasting relationships with its existing customers. But how could the bank ensure it had the right data, ability to efficiently sift through it and put it to work to benefit the bank and its customers? FIS enabled them to fully engage their connected clients and achieve real bottom-line results.

[Read more](#)



Wintrust, a community bank competing against bigger banks in a major metropolitan market, needed to stand out in the crowd and grow its customer base. FIS Cardless Cash is the catalyst that is helping to sell them apart immediately. This mobile-based solution is helping Wintrust grow aggressively, revolutionize its user experience and target the young and mobile customer of the future – putting it ahead of its much larger competition.

[Read more](#)



FIS transformed how COUNTRY Financial's advisors do business, enabling them to spend more time doing what they do best: building customer relationships one-on-one.

[Read more](#)



FIS corporate actions solution suite transformed ICBGS' S, streamlining manual processes, reducing risk and gaining enormous efficiencies while improving service levels. Now, ICBGS' customers have the confidence of timely and thorough notification of corporate actions affecting their positions.

[Read more](#)



FIS technology has helped LBBW meet some of the world's most complicated financial products to meet growing demands for structured products, respond swiftly to new market opportunities and adapt to regulatory change, delivering an agile platform that LBBW needs to support its current and future growth.

[Read more](#)



FIS investment operations solution suite helped Maltland change the way their customers can make portfolio decisions, delivering a scalable, right front-to-back-office integration solution that provides real-time data on 70,000 trades per month. By helping Maltland give its customers an edge, FIS helped it achieve real financial consequences – in terms of revenue growth, cost reduction and service quality.

[Read more](#)



FIS guided Oriental through an acquisition that doubled its size, helping to drive its business forward and reinvent itself with new operating and technology models and lending capabilities that meet the unique needs of Puerto Ricans. And Oriental – now the island's third-largest bank – transformed the banking experience and became Puerto Rico's most customer-centric bank.

[Read more](#)